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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,683	05/10/2001	Omolayo O. Fomadu	BB-1270	7062

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E I du Pont de Nemours & Company
Legal Patents
Wilmington, DE 19898

EXAMINER

BUI, PHUONG T

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,683

Applicant(s)

FOMADU ET AL.

Examiner

Phuong T. Bui

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-70 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 58-70 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/13/01</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Restriction election

1. The Office acknowledges the receipt of Applicant's amendment and restriction election filed December 17, 2003. Applicant elects Group 1 and Invention E (SEQ ID NO:9 encoding SEQ ID NO:10) without traverse. Claims 58-70 are pending and are examined in the instant application. This restriction is made FINAL.

Sequence Listing

2. Applicant's CRF and paper sequence listing have been entered. However, upon examination of SEQ ID NO:9 and its corresponding amino acid sequence SEQ ID NO:10, it is unclear what region of SEQ ID NO:9 encodes SEQ ID NO:10. Clarification is required.

Information Disclosure Statement

3. An initialed and dated copy of Applicant's IDS form 1449 filed September 13, 2001 is attached to the instant Office action.

Claim Rejections - 35 USC § 112, second paragraph

4. Claims 58-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims which recite "Clustal V method of alignment", it is unclear whether "Clustal V method of alignment" is the same as "Clustal method of alignment" disclosed in the specification (p. 23). Clarification and/or correction are required.

Claim Rejections - 35 USC § 112, first paragraph

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5. Claims 58-61 and 64-70 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for SEQ ID NO:9 or a polynucleotide encoding SEQ ID NO:10, does not reasonably provide enablement for sequences having less than 100% sequence identity with these sequences. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Claims reciting less than 100% sequence identity are not enabled because they encompass unspecified base deletions, additions, substitutions, and combinations thereof while retaining enzymatic activity. While skilled in the art can readily make base changes, further guidance is necessary as to what changes would be tolerated. Applicant provided no guidance as to what regions of the claimed sequences should be retained for enzymatic activity. Applicant disclosed no working examples of any sequences having less than 100% sequence identity with SEQ ID NO:9 or a polynucleotide encoding SEQ ID NO:10. Absent of further guidance, one skilled in the art cannot make and use the claimed invention without undue experimentation. Accordingly, the claimed invention is not enabled.

6. Claims 58-61 and 64-70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims reciting 80-95% sequence identity lack adequate written description because Applicant does not

disclose a representative number of species as encompassed by these claims. The claims encompass mutants and allelic variants and thus imply that structural variants exist in nature, yet no structural variant has been disclosed. The claims also encompass glutamyl-tRNA synthetase from other species. The implication is that there is a gene and a protein other than that disclosed which exists in nature, but the structure thereof is not known. Applicant discloses a single sequence SEQ ID NO:9 isolated from *Zea mays*. Thus, there is insufficient relevant identifying characteristics to allow one skilled in the art to predictably determine such mutants, allelic variants and glutamyl-tRNA synthetases from other plants and organisms, absent further guidance.

Accordingly, there is lack of adequate description to inform a skilled artisan that applicant was in possession of the claimed invention at the time of filing. See Written Description guidelines published in Federal Register/ Vol.66, No. 4/ Friday, January 5, 2001/ Notices; p. 1099-1111.

Remarks

7. No claim is allowed. SEQ ID NO:9 and a nucleotide sequence encoding SEQ ID NO:10 are free of the prior art. It is understood by the Office the recited Clustal V alignment method uses the default parameters set forth on page 23, lines 17-19 of the specification. The closest prior art teaches a glutamyl-tRNA synthetase from *Arabidopsis thaliana* having 67% sequence identity with SEQ ID NO:10 at the amino acid level (Table 6, p. 24).

8. Papers relating to this application may be submitted to Technology Sector 1 by facsimile transmission. Papers should be faxed to Crystal Mall 1, Art Unit 1638, using fax number (703) 308-4242. All Technology Sector 1 fax machines are available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such

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papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Bui whose telephone number is (571)272-0793.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Amy Nelson, can be reached at (571)272-0804.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Phuong Bui
Primary Examiner
Art Unit 1638
February 16, 2004


PHUONG T. BUI
PRIMARY EXAMINER